REMARKS/ARGUMENTS

Applicant submits this response to the Office Action dated March 13, 2006. The remarks and arguments presented herein place claims 1-23 in condition for allowance. Applicant notes the rejection of certain claims of the present application based upon 35 USC §112, ¶1, 35 USC §102(b) over U.S. Pat. No. 3,483,863 ("DeVane"), and 35 USC §103(a) over U.S. Pat. No. 4,142,337 ("Holcomb"), U.S. Pat. No. 5,727,264 ("Craig et al."), and U.S. Pat. No. 4,090,266 ("Price").

Applicant respectfully requests reconsideration and allowance of this application in view of the following amendments and comments. Upon entry of the amendment presented herein, claims 1-23 will remain in this application. Claims 24-28 have previously been cancelled.

By the amendments presented the specification has been amended to provide support for claims 1, 3, 6, 8, 9, 10, 11, 14, 16, and 20-22. Support for these amendments can be found throughout the specification, and is detailed below. In view of sufficient support for the amendments, Applicant submits that no new matter has been added as a result of the present amendment.

Objections under 37 CFR §1.83(a)

A proposed amended Figure 3 of the drawings is attached to the Appendix. Figure 3 has been amended to show the operating controls 325 of claims 8 and 20 and the plumbing controls 330 of claim 21. Support for the matter set forth in claims 8, 20, and 21 can be found in the paragraph beginning on page 15, line 1 as amended.

Support for the "twist-lock" fasteners set forth in claim 13 can be found in the paragraph beginning on page 12, line 21 as amended, "The twist lock fasteners can be substituted for the bolts."

No new matter has been added. Applicant respectfully asserts that the drawings as proposed will overcome the Examiner's objection.

Objections under 37 CFR §1.75(d)(1) and MPEP §608.01(o)

In the specification, the paragraphs beginning on page 9, line 20; page 12, line 21; page 13, line 3; and page 16, line 3 have been amended to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP §608.01(o). Support for the amendment to the paragraph beginning on page 9, line 20 can be found on page 20, claim 10 of the original application, "wherein the assembly is capable of being installed in a balanced manner, supported by both the flat upper lip and the bottom footwell, without the use of sandbags."

Support for the amendment to the paragraph beginning on page 12, line 21 can be found on page 21, claim 11 of the original application, "wherein the assembly is capable of being attached to an upper rim of the gunite spa cavity by securing elements."

Support for the amendment to the paragraph beginning on page 13, line 3 can be found on page 21, claim 14 of the original application, "wherein the securing elements travel directly down through the upper lip and attach to the gunite spa cavity."

Support for the amendment to the paragraph beginning on page 16, line 3 can be found on page 19, claim 3 and page 21, claim 16 of the original application, "wherein the notch has dimensions from between four and six inches in height to one to two inches in depth."

With regards to the "return" element set forth in claims 1, 9, and 22, it is respectfully asserted that proper antecedent basis can be found on page 9, lines 9-12, "The assembly 100 further includes plumbing elements 130 attached or otherwise associated with the shell tub portion 120. These plumbing elements are related to the suction or the *return* water flow within the spa assembly." (emphasis added.)

Applicant respectfully asserts that the specification as amended overcomes the Examiner's objections.

Rejections under 35 USC 112, ¶1

Claims 1-8 have been rejected under 35 USC 112, ¶1 for lack of enablement. Specifically, claim 1 recites, an upper flange "being constructed so as to support the weight of the spa on the rim of the gunite spa cavity." The Examiner states that this subject matter is neither taught by the instant disclosure nor evident to the Examiner.

The paragraph beginning on page 9, line 20 of the specification has been amended to add the language "[t]he flat upper flange 126 is constructed so as to support the entire weight of the spa on the rim of the gunite spa cavity." Support for the amendment to this paragraph can be found on page 19, claim 1 of the original application. Moreover, further support for the upper flange "being constructed so as to support the weight of the spa on the rim of the gunite spa cavity" can be found on page 10, line 1, "In these embodiments, this flange could sit on the gunite portion of the spa bond beam and dam wall, and can be fastened using a variety of fastening means (e.g., stainless steel or bronze bolts or fasteners), directly to the bond beam and dam wall *to prevent any movement or separation* from the pool/spa shell." (emphasis added.) Applicant respectfully asserts that the specification as amended overcomes the Examiner's rejection of claims 1-8.

Claim 6 has been rejected under 35 USC §112, ¶1 for lack of enablement. Specifically, claim 6 recites, a "readily" "removable" shell. The Examiner states that this subject matter is neither taught by the instant disclosure nor evident to the Examiner. The Examiner states that the backfill 204, as well as the glue/bonding would appear to preclude this claimed feature.

Page 12, line 22 states that "[t]he spa insert *may* be first glued or bonded to the top of the spa cavity then fixed by fasteners, such as bolts..." (emphasis added.) It is asserted that the word "may" is an auxiliary verb which is used to indicate a possibility or probability. See Merriam-Webster Online Dictionary at (www.m-w.com). As a result, it is not required that the spa insert be glued or bonded to the cavity. Therefore, if the user does not choose to glue or bond the spa insert to the spa cavity, the spa could be "readily removable" by undoing the simple mechanical securing elements and fasteners, i.e. bolts, twist lock fasteners, screws, etc., the operation of which are commonly known to those skilled in the art. It is respectfully asserted that the "readily" "removable" elements are supported by the specification and overcomes the Examiner's rejection of claim 6.

Moreover, page 10, lines 19-20, state that "[T]hese access ports can also allow an opening for the backfilling of sand around the installed spa insert." Page 11, lines 16-18 state that, "[O]nce the insert is placed into the cavity, the cavity is backfilled with sand 204, or a similar material." Page 15, lines 9-11, state that, "[a]fter the assembly has been set in place and

plumbed, the remaining space between the in-ground spa walls and the spa insert (with the associated plumbing/electrical lines) is back-filled with sand and water-jetted to achieve maximum compaction around the assembly." It is asserted that the purpose of the backfill is to keep the spa insert from moving within the spa cavity. In fact, the specification suggests the use of material such as sand for the backfill. Sand can be easily removed with simple digging materials, which is commonly known to those skilled in the art. Nowhere is it suggested that the backfill is used to *permanently* secure the spa insert within the cavity. It is respectfully asserted that the "readily" "removable" elements are supported by the specification and overcomes the Examiner's rejection of claim 6.

Claims 8, 20, and 21 have also been rejected under 35 USC §112, ¶1 for lack of enablement. Specifically, the Examiner states that implementation of the claimed subject matter (operating controls and plumbing controls) is neither taught by the instant disclosure nor evident to the Examiner.

It is asserted that the prior art is replete with examples of operating controls and plumbing controls that would require no undue experimentation to practice the invention. (See e.g., Janoski, et al. (U.S. 4,233,694), Hancock (U.S. 4,780,917), and Seneff (U.S. 6,079,950.)) In fact, the prior art cited by the Examiner, Craig et al., details the use of operating controls and plumbing controls: "[s]uitable water inlets, water turbulence generating means, i.e., pressurized water inlets, water skimming means, and other conventional spa or therapy unit accessories and controls therefore, are provided. The controls for operation of the spa are preferably accessible by the occupant of the spa. These controls located on the spa may include means interlocked with those for the swimming pool and are preferably devised to override the filter pump, water heater, and the like, controls that service the swimming pool." (Craig et al., col. 2, lines 9-18.) Due to the existence of numerous working examples in the prior art, including the prior art cited by the Examiner, Applicant respectfully traverses this objection. Indeed, it is the law that "a patent need not teach, and preferably omits, what is well known in the art." *Hybritech v. Monoclonal Antibodies, Inc.*, 802 F2d 1367, 1384 (Fed. Cir. 1986.) Applicant does not claim to have invented new operating controls or plumbing controls. Applicant is merely claiming these known limitations and is combining them in a patentable way with the inventive limitations of the claims.

Applicant respectfully asserts that Applicant has overcome the Examiner's 35 USC §112, ¶1 rejections, and claims 1-8, 20, and 21 are in condition for allowance.

Rejection under 35 USC §102(b)

Claims 1, 4-7, 9, and 17-19 have been rejected under 35 USC §102(b) as allegedly anticipated by DeVane. In part, the Examiner states that DeVane discloses a spa assembly comprising a shell including a tub portion, a flange and a spillway (DeVane, Fig. 3), and plumbing elements including a suction and a return. The Examiner further states that the shell is capable of being fitted into a gunite spa cavity.

DeVane discloses the following therapy pool: "A therapy pool for use in an existing swimming pool having a pump, heater and heated water inlet, said therapy pool comprising a hollow tank, means for mounting said tank within said swimming pool, said tank having a water inlet and a water outlet, means connecting said water inlet of said tank to said heated water inlet of said swimming pool, so that said tank is supplied with water heated by said heater and moved by said pump, whereby the water in said tank can be heated to a temperature substantially greater than that of the water in said swimming pool, to provide a therapy pool within said swimming pool." (DeVane, col. 3, line 52 – col. 4, line 5.)

DeVane simply fails to teach or suggest a spillway. Applicant respectfully asserts that the side of the tank opposite flange 12 is not a spillway as the Examiner suggests. As defined by the Applicant, a spillway "allows water to flow between the pool and spa in the same fashion as a traditional gunite packaged pool/spa system" (page 5, lines 19-21.) Instead of a spillway, DeVane specifically teaches an equalizer outlet (31) at the bottom of the tank, "to maintain the same water level in the tank and pool."

The side of the tank opposite the flange cannot be a spillway because that would allow the uncontrolled flow of water between the pool and the spa. This uncontrolled flow would allow the cooler water of the pool to mix with the hotter water of the spa, thereby defeating the purpose of the spa, which is to maintain a small amount of hot water. In fact, DeVane specifically teaches that its invention is an improvement over the prior art because, it allows persons suffering from arthritis or other conditions for which hot water therapy is indicated can enjoy such therapy by "merely heating the relatively small amount of water in the therapy pool

to a high degree without undergoing the expense of heating the entire swimming pool" (DeVane, col. 1 lines 54-57.) For this reason, the side opposite flange 12 as disclosed in Fig. 3 of DeVane cannot be a spillway.

It is further asserted that the flange 12 in DeVane is also not a "spillway." As disclosed in DeVane, the flange is used to secure the tank to the coping of the swimming pool, "One side of tank 10 is provided with a horizontally extending flange 12, which may be formed integrally with the tank 10. The flange 12 overlies and is secured to the coping of a swimming pool 13 by concrete fastening members 14, which are preferably of the expanding bolt type." (DeVane, col. 2, lines 28-32.) The DeVane flange does not permit water to flow between the pool and spa. In fact, as shown in DeVane Fig. 3, the flange (12) is higher than the opposite wall of the tank.

Accordingly, since DeVane fails to teach a spillway, withdrawal of this rejection is respectfully requested.

Rejection under 35 USC §103(a)

Claims 1, 4-14, and 17-20 have been rejected under 35 USC §103(a) as obvious over Holcomb and Craig et al. The Examiner states that Holcomb teaches all claimed elements (a shell including a tub portion, a flange, and plumbing elements including a suction and return) except for the provision of a spillway and the provision of operating controls. The Examiner states that Craig et al. discloses an analogous spa which further includes a spillway and operating controls. The Examiner concludes that it would have been obvious for one skilled in the art to associate the spillway and operating controls taught by Craig et al. with the Holcomb shell in order to enable installation and facilitate operation of the spa assembly.

Claims 2, 3, 15, 16, 22, and 23 have been rejected under 35 USC §103(a) as obvious over Holcomb and Craig et al, as applied to claims 1 and 9 above, and further in view of Price. The Examiner states that although the shell of the Holcomb spa assembly does not include a notch for tile installation, Price teaches an analogous spa assembly which further includes a shell and a notch for tile installation. The Examiner concludes that it would have been obvious for one skilled in the art to associate a notch with the Holcomb shell to enable tile installation.

Applicant respectfully traverses this rejection. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The requisite motivating suggestion must be explicit. *Winner International Royalty Corp. v. Wang*, 48 USPQ.2d 1139 (D.C. 1998) ("...there must have been some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention."). The Examiner must identify where the prior art provides a motivating suggestion for the combination. *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992).

The applicant respectfully submits that there is no motivation express or implied for combining the teachings of Holcomb, Craig et al., and Price because the three systems are used for completely different purposes and perform different functions. First, Holcomb, teaches a stand-alone spa assembly in which stakes are driven into the ground to support the lip of the spa shell after which the concrete grout is pumped into the hole around the shell: "To install the shell 12 in the ground 16 and thereby complete the fabrication of the spa 11, a hole 34 is dug in the ground 16, the hole being made somewhat larger than the shell 12 and its plumbing. Three stakes 36 (more can be used if desired) are then driven into the bottom of the hole 34.... The stakes 36 are spaced around the periphery of the hole 34 so that the lip 13 of the shell 12 is supported on the tops of the stakes 36, as shown in broken line in FIG. 1...With the stakes 36 driven into place, the shell 12 with affixed plumbing is lowered into the hole 34 so that the lip 13 rests on the stakes 36, the shell 12 being thereby supported by the stakes 36. Concrete grout 37 in the form of slurry is then pumped into the hole 34 around the shell 12." (Holcomb col. 3, line 55 – col. 4, line 20.) Holcomb teaches the laborious method of balancing the shell on stakes and filling the area between the shell and the earth or spa insert.

Craig et al. teaches the use of X-brace support systems of the wall panels to support the spa shell as concrete is poured around the spa shell: "[T]he X-Brace bracing system, as illustrated in FIG. 6, comprises a pair of cross members 30 and 32, preferably formed of metal but these members may comprise any suitable rigid material such as wood or plastic. The members 31 and 32 are connected at 30, i.e., at a point intermediate the ends thereof, and are suitably secured and held in place at the base thereof, such as by means of stakes 36, until

concrete 39 is poured at these bottom ends of the legs ends and hardens thereby fixing the bracing member legs 31 and 32 in place. The top of the brace leg 31 and the bottom of brace leg 32 are secured at 34 to the wall supporting flanges 33 (see FIG. 6)." (Craig et al., col. 9, lines 19-30.) Craig et al. does not teach or suggest the assembly of an independent spa system, such as, e.g., Holcomb. Quite the opposite, Craig et al. teaches an integrated spa and pool assembly where the outer wall panels function as the wall panels of the adjoining swimming pool. In Craig et al., support panel 11a "functions in the dual capacity as a part of the swimming pool vertical supporting wall and as a part of the outer vertical support wall for the spa 18." (Craig et al., col. 7, lines 49-52.) It is respectfully asserted there is no motivation to combine the references of Holcomb and Craig et al because of these important differences between the resulting products.

Price is directed to a wall assembly for a swimming pool. Price teaches fiberglass panel members which extend upwardly from a concrete footing with vertical concrete columns located on the outside of and providing lateral support to the panel members. The fiberglass panel members are arranged side-by-side in a row about the periphery of the pool with a concrete column positioned along the length of each joint between two adjacent panel members. The joints between the panel members are sealed by the concrete columns. (Price, col. 1, line 50 – col. 2, line 16.) Price does not teach nor suggest the assembly of a stand-alone integrated spa and pool system such as, e.g., Holcomb or a spa assembly where the outer wall panels function as the wall panels of the adjoining swimming pool to support the spa shell such as, e.g., Craig et al. Price is directed to a certain wall assembly whereby wall panels of a pool are supported by vertically oriented concrete beams. Price does not even teach a spa insert for insertion into a cavity. It is respectfully asserted that there is no motivation to combine the references of Holcomb and Craig et al. with Price because of these important differences between the resulting products.

It is respectfully asserted that the Examiner improperly combines the structures of the prior art references without regard to the functions of those structures. It is a bedrock principle of patent law that rejecting patents solely by finding prior art corollaries for claimed elements would permit the examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention - such an approach

would be an "illogical and inappropriate process by which to determine patentability." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998.)

In summary, the diametrically opposite structural functions of Holcomb, Craig et al., and Price cannot be combined to support an obviousness rejection. The apparatus in Holcomb is supported on stakes with no connection to the structural elements of a pool. In fact, the Holcomb spa insert is used independent of a pool. In contrast, the apparatus in Craig et al. specifically incorporates the wall panels of the adjoining pool to support the spa insert. Specifically, the Craig et al. spa insert cannot be constructed without the wall panels of an adjoining pool. Lastly, Price is directed to a certain wall assembly whereby wall panels of a pool are supported by vertically oriented concrete beams. Price does not even teach a spa insert for insertion into a cavity. It is respectfully asserted that Price bears no relationship to either Holcomb, Craig et al., or Applicant's invention, and is used for a completely different purpose and function. For these reasons withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicant respectfully submits that claims 1-23 are in condition for allowance. The Examiner is encouraged to call the undersigned collect at (415) 705-6377 if there are any questions, or if it will expedite allowance of this application. The Commissioner is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment to Deposit Account No. 04-0822.

Respectfully submitted,
DERGOSITS & NOAH LLP

Date: August 28, 2006

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